REMARKS

Applicant appreciates Examiner's assistance and respectfully requests reconsideration and allowance of the subject application. Claims 1-2, 4-33 are pending in this application.

Rejection of the Claims

Claims 1-2, 4-12, 16, 19-33

Applicant has addressed the rejections of claims 1-2, 4-12, 16, 19-33 in Applicant's response of March 30, 2004. The present response is supplemental and addresses a rejection of claims 13-15 and claims 17-18.

35 U.S.C. § 103(a)

Claims 13-15 and 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,243,705 to Kucala (the "Kucala reference" or "Kucala") in view of Admitted Prior Art.

Nature of Admitted Prior Art ("APA")

The Examiner has facilitated prosecution by pointing out or reiterating that the reference "Admitted Prior Art" (APA) means a segment of the background section of Applicant's specification on page 3, lines 8-13:

> "Typically, when a portable computer is synchronized with a base computer, objects that have been modified since the last synchronization process are synchronized such that the portable computer and the base computer contain identical objects. Further, during each synchronization process, if an object has been deleted on the portable computer or the base computer since the last synchronization process, then the corresponding object on the other system is also deleted."

<u>Claim 13</u>

<u>The Kucala Reference Combined With APA Does Not Establish A Prima Facie Case Of Obviousness</u>

As stated in the MPEP § 2143.01, to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (<u>In re Royka</u>, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). "All words in a claim must be considered in judging the patentability of that claim against the prior art." (<u>In re Wilson</u>, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. (<u>In re Fine</u>, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Neither the Kucala reference or the APA, singly or in combination, teach or suggest all of Applicant's claim elements. In particular, the Kucala reference and the APA do not teach or suggest the subject matter of claim 13. For at least the following reasons, Applicant submits that the rejection under §103 is traversed.

Applicant's claim 13 defines a method of:

> synchronizing objects between a portable computer and a base computer, wherein the base computer attempts to delete objects during synchronization if corresponding objects are not accessible to the portable computer, the method comprising:
> storing an object on a removable storage device, wherein the removable storage device is configured to be inserted into and removed from the portable computer;
> automatically creating an association between the object and a corresponding object on the base computer; and
> without user intervention, synchronizing the object stored on the removable storage device with the corresponding object on the base computer if the removable storage device is inserted into the portable computer; and

without user intervention, automatically preventing the corresponding object on the base computer from being deleted if the removable storage device is not inserted into the portable computer.

Applicant fails to find the subject matter of claim 13 in the Kucala reference. For example, the Kucala reference does not disclose preventing the corresponding object on the base computer from being deleted if the removable storage device is not inserted into the portable computer. Further, Applicant fails to find this untaught subject matter in the APA. Consequently, Applicant respectfully asserts that the Office has failed to establish a prima facie case of obviousness.

Applicant further asserts that the Kucala reference teaches away from the claimed subject matter. For example, during a synchronization of records on a portable computer (palmtop) with records on a base computer (PC), the Kucala reference teaches a type of synchronization that deletes an unchanged record from both the portable computer and from the base computer if the record has been previously deleted from either. In contrast, Applicant's claims address issues related to preventing an unchanged record from being deleted from either the portable computer or from the base computer if the record is currently unavailable to the portable computer. Consequently, the Kucala reference teaches away from Applicant's claimed subject matter..

In the Office Action of December 31, 2003, the Office cites col. 3, lines 24–32 of the Kucala reference as evidence to support its obviousness finding. In particular, the Office points to this section of the Kucala reference in an effort to show that during synchronization an object on a base computer is prevented from being deleted if the corresponding object is not on the storage device of a portable computer, i.e., "that the desktop file is not deleted when the corresponding file is not an the handheld" (page 13, Office Action of December 31, 2003). Column 3,

lines 24-32, however, do not refer to the Kucala synchronization process, but only to creation of an initial backup directory—column 3, line 24 begins, "To create an initial backup directory 203...." Thus, the evidence the Office relies on does not, in fact, exist at column 3, lines 24-32.

Kucala's initial backup directory 203 can be visualized in Kucala's Fig. 1, and "contains a backup file that stores the file state from a previous synchronization of the PC 200 and the palmtop 100" (col. 3, 18-20). Thus, the backup file 203 and its formation are not the same as—but instead are separate from—the synchronization process taught by Kucala.

Kucala's synchronization process can be visualized in Kucala's Fig. 2: "Fig. 2 illustrates the record synchronization process ..." (col. 4, line 3). Records in a PC file and records in a corresponding palmtop file are each compared to corresponding records in the backup directory 203 (mentioned above) to determine new, updated or deleted records (col. 4, lines 9-13). The results of the compare operations are then used to create a single reconcile file 204 *that contains all* the new records, modified records, and unmodified records (col. 4, lines 14-16, emphasis added). "The contents of the reconcile file 204 are then copied to PC file 201, palmtop file 101, and backup calendar file 202 in backup directory 203 (FIG. 3). All three calendar files are thus synchronized" (col. 4, lines 17-20). In other words, the reconcile file 204 replaces all corresponding files to effect synchronization.

The Kucala reference describes the logic for the abovementioned compare operations that are used to create the single reconcile file 204 that contains all the records of a completed synchronization file: "To *fully describe* what occurs during the comparison process, Table 1 *lists all the possible cases* and what occurs

during the record synchronization process..." (col. 4, lines 31-34, emphasis added).

In Kucala's Table 1, there are columns labeled "Condition," "Result," and "Method." In the "Condition" column, the third condition in the list is, "Record was deleted from one file but still exists in the other." This pertains to a record deleted from one file and unchanged in the other file. The corresponding result for this conditions is, "Neither record is copied into the reconcile file." Since the reconcile file is the single file that contains all the new records, modified records, and unmodified records (as above, and at col. 4, lines 14-16) and since the contents of the reconcile file are copied to the PC file, palmtop file, and backup file, replacing them to effect a synchronization (col. 4, lines 17-20), a record that is missing in one file but still exists unchanged in the other file at the time of a Kucala synchronization is eliminated from all files: from the PC file, from the palmtop file, and from the backup file used for a future synchronization. In other words, if an unchanged record has been deleted from either the PC or the palmtop, the record will be deleted completely from both during synchronization. This is the very condition that Applicant's subject matter seeks to remedy. Thus, the Kucala reference and the APA, either singly or in combination, do not establish a prima facie case of obviousness: sufficient and objective evidence is lacking as to teach or suggest the claimed subject matter.

Applicant respectfully submits, therefore, that claim 13 is allowable over the cited art.

Claims 14-15, and 17-18

Claims 14-15 and 17-18 are dependent on claim 13. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is

nonobvious (In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). For at least the reasons explained above with respect to claim 13, Applicant respectfully submits that claims 14-15 and 17-18 are also allowable over the cited art.

CONCLUSION

Applicant respectfully suggests that claims 1-2, and 4-33 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. Should any matter in this case remain unresolved, the undersigned attorney respectfully requests a telephone conference with the Examiner to resolve any such outstanding matter.

Respectfully Submitted,

Date: 6-16-04   By: _____

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